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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,780	04/28/2000	Kazutoshi Okuno	85761-000510US	5157
20350	7590	07/17/2003		
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER	
			KUBELIK, ANNE R	
		ART UNIT	PAPER NUMBER	
		1638		

DATE MAILED: 07/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/560,780	OKUNO ET AL.	
	Examiner	Art Unit	
	Anne R. Kubelik	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 06 May 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1 and 4 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 and 4 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on with the application is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

### **DETAILED ACTION**

1. The amendments to the specification, the cancellation of claims 2-3 and 5-6, and the amendment of claims 1 and 4 requested in the paper filed 6 May 2003 have been entered.  
Claims 1 and 4 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Response to Arguments***

3. The rejection of claims 1-6 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is WITHDRAWN in light of Applicant's evidence that the sequence of G271 was known prior to filing.
4. The rejection of claims 1-4 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is WITHDRAWN in light of Applicant's showing that polymorphisms were known for G271. It is noted by Examiner that the information at <ftp://rgp.dna.affrc.go.jp/pub/japonicarice/tableall.txt> cannot be printed in its entirety. The Rice Genome Research Program analyzed polymorphisms in 120 rice cultivars; the printout made of record only shows 24 of those cultivars. RFLP polymorphisms are seen in one of those 24 cultivars.

#### ***Response to Amendments***

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5. The rejection of claims 1 and 3 under 35 U.S.C. 102(b) as being anticipated by Fukuoka et al is WITHDRAWN in light of cancellation of claim 3 and amendment of claim 1 to recite G271 as the DNA marker.

6. The rejection of claims 1, 3-4 and 6 under 35 U.S.C. 103(a) as being unpatentable over Fukuoka et al is WITHDRAWN in light of cancellation of claims 3 and 6 and amendment of claims 1 and 4 to recite G271 as the DNA marker.

***Claim Rejections - 35 USC § 112***

7. Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. The rejections are new, due to amendment of the claims.

Claims 1 and 4 are indefinite in their recitation of “detecting the presence or absence ... DNA marker G271” in lines 4-6. Is Applicant implying that G271 hybridizes to the DNAs of some rice cultivars and not to others? The evidence of Rice Genome Research Program, <ftp://rgp.dna.affrc.go.jp/pub/japonicarice/tableall.txt>, September 1996 suggests that it hybridizes to the DNA of all. Does Applicant instead mean that one should look for the presence of the polymorphism present in rice blast resistant cultivars?

***Claim Rejections - 35 USC § 102***

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the Rice Genome Research Program, <ftp://rgp.dna.affrc.go.jp/pub/japonicarice/tableall.txt>, September 1996.

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The web site indicates DNA polymorphisms seen in a number of rice cultivars when probed with a number of clones, including G271. Because the polymorphisms are based on restriction enzymes digests, the method used was RFLP analysis, which would have inherently involved isolation of genomic DNA from the rice plants. The "presence or absence of the DNA marker G271 in the DNA" was detected. Thus, because the website teaches all the steps of the method, the website inherently teaches the method.

9. Claim 4 is free of the art, given the failure of the prior art to teach or suggest a method of rice breeding using G271.

10. Claim 4 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

### ***Conclusion***

11. No claim is allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (703) 308-5059. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (703) 308-0198.

Anne R. Kubelik, Ph.D.  
July 11, 2003

